

REMARKS/ARGUMENTS

Claims 1-11, 20-30, 39-49, and 82-105 are pending in this application. Claims 1-11, 20-30, and 39-49 were withdrawn without prejudice. Claims 12-19, 31-38, and 50-81 were canceled without prejudice in any manner. New claims 82-105 were added to more distinctly claim the invention. Support for the new claims can be found in the specification. No new matter has been added.

Claims Rejected

Claims 74-81 were rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Additionally, claims 58-81 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Moreover, claims 58-81 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Also, claims 58-62, 66-70, and 74-78 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Eddy. In order to expedite prosecution of the above identified application, Applicants have canceled claims 58-81 without prejudice in any manner.

New Claims

Claims 82-105 have been added to better claim the invention. Specifically, claims 82-89, 90-97 and 98-105 correspond to original claims 12-19, 31-38 and 50-57 with amendments. These new claims comply with at least the requirements of 35 U.S.C. § 112, first paragraph and second paragraph, and are in condition for allowance.

In the previous Office Action mailed December 30, 2003, the original claims 12-19, 31-38, and 50-57 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Examiner asserted that "the specification exemplifies that the thresholds or criteria are not automated, rather given selected thresholds certain hits are retained or discarded automatically." (Office Action mailed December 30, 2003,

page 4). In order to expedite prosecution of the above identified application, new claims 82, 90, and 98 each recite “determining a plurality of scores by comparing the plurality of protein sequences with the plurality of models” and “automatically selecting a plurality of hits based on at least the plurality of scores and a plurality of criteria” without prejudice in any manner.

Additionally, the Examiner asserted that “[t]he Board stated that although the level of skill in the molecular biology is high, the results of experiments in genetic engineering are unpredictable.” (Office Action mailed December 30, 2003, page 3). In response, the Applicants would like to point out that the subject matter of pending claims is related to bioinformatics, which is different from molecular biology and genetic engineering. “A single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements.” (MPEP, § 2164.03).

Also in the previous Office Action mailed December 30, 2003, claims 14-19, 33-38, and 52-57 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In order to expedite prosecution of the above identified application, new claims 84-86, 92-94, and 100-102 each recite “the plurality of protein sequences” without prejudice in any manner. Moreover, new claims 89, 97, and 105 each recite “analyzing a plurality of slopes for a plurality of curves” without prejudice in any manner.

Accordingly, claims 82-105 are asserted to be allowable for at least the above reasons.

Claims Distinguished over Cited Reference

The Examiner has based the prior art rejection on Eddy. Applicants respectfully submit that the cited reference does not disclose or suggest all limitations of claim 82. More particularly, claim 82 recites “automatically selecting a plurality of hits based on at least the plurality of scores and a plurality of criteria” and “assigning the plurality of protein sequences to the plurality of models based on at least the plurality of selected hits.” Eddy does not appear to disclose or suggest all these claim limitations. Accordingly, claim 82 is asserted to be allowable for at least the above reasons.

In light of the above, it is asserted that claims 83-105 are allowable for substantially the same reason as claim 82, and more particularly for the specific limitations they recite.

Claims Withdrawn

Claims 1-11, 20-30, and 39-49 were withdrawn without prejudice. The Examiner asserted that "[a] complete reply to the final rejection must include cancellation of non-elected claims or other appropriate action" and cited 37 CFR § 1.144 and MPEP § 821.01. (Office Action mailed July 26, 2004, page 2). But 37 CFR § 1.144 refers to petition from requirement for restriction, and MPEP § 821.01 is titled "After Election With Traverse." In contrast, the Applicants has made an election without traverse. Hence 37 CFR § 1.144 and MPEP § 821.01 do not appear to be applicable.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Daniel Mao
Reg. No. 51,995

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
DM:ejt
60310622 v2